

REMARKS

INTRODUCTION:

In accordance with the foregoing, claim 9 has been canceled, claims 1, 12 and 15 have been amended. No new matter is being presented, and approval and entry are respectfully requested.

Claims 1, 5, and 7-19 are under consideration. Claims 20-22, 31-39 and 41-47 are withdrawn. Reconsideration is respectfully requested.

ELECTION/RESTRICTIONS

Applicants confirm that Group 1, claims 1, 5 and 7-19 are elected. Claims 20-22, 31-39 and 41-47 have been withdrawn.

CLAIM OBJECTIONS

Claims 12 and 15 were objected to because of informalities.

Claim 12 has been amended to cancel the second urethane-containing formula, and claim 15 has been amended to cancel the period just before formula (3).

Thus, claims 12 and 15 are submitted to be corrected.

REJECTION UNDER 35 U.S.C. §112:

In the Office Action, at pages 3-4, numbered paragraph 10, claims 1, 5, and 7-19 were rejected under 35 U.S.C. §112, first paragraph, for the reasons set forth therein. This rejection is traversed and reconsideration is requested.

It is respectfully submitted that there was a typographical error in claim 1. Claim 1 has been amended to correct "a 100 mm thick area" to recite ---a 100 µm thick area---. Thus, claim 1 is now submitted to be enabling under 35 U.S.C. §112, first paragraph.

Since claims 5 and 7-19 depend from amended claim 1, claims 5 and 7-19 are also submitted to be enabling under 35 U.S.C. §112, first paragraph.

REJECTION UNDER 35 U.S.C. §102:

A. In the Office Action, at pages 4-5, numbered paragraphs 12-13, claims 1, 9 and 16 were rejected under 35 U.S.C. §102(e) as being anticipated by Fong et al. This rejection is traversed and reconsideration is requested.

Claim 1 has been amended to recite that the base member is a glass lens and that said resin composition has a refractive index before polymerization curing of 1.52 or more. Claim 9 has been cancelled without prejudice or disclaimer.

Fong et al. fails to teach a resin-cemented optical element having a base member that is a glass lens, wherein the resin composition has a refractive index before polymerization curing of 1.52 or more, as is recited in amended claim 1 of the present invention (see lines 4-13 of page 14 of the specification and Table 1, page 34).

Thus, it is respectfully submitted that amended claim 1 of the present invention is not anticipated by Fong et al. (USPN 5,932,626) under 35 U.S.C. §102(e). Since claims 9 and 16 depend from amended claim 1, claims 9 and 16 are submitted to be not anticipated by Fong et al. (USPN 5,932,626) under 35 U.S.C. §102(e) for at least the reasons that amended claim 1 is submitted to be not anticipated by Fong et al. (USPN 5,932,626) under 35 U.S.C. §102(e).

B. In the Office Action, at pages 5-6, numbered paragraphs 14-16, claims 1, 5, 7-8, 10-12 and 16 were rejected under 35 U.S.C. §102(e) as being anticipated by Lin et al. This rejection is traversed and reconsideration is requested.

Claim 1 has been amended to recite that the base member is a glass lens and that said resin composition has a refractive index before polymerization curing of 1.52 or more. Claim 9 has been cancelled without prejudice or disclaimer.

It is respectfully submitted that Lin et al. teaches a radiation curable fiber optic coating composition that includes a coloring agent that imparts a pre-selected color to the coated fiber optic, but fails to teach using a glass lens as a base member or a resin-cemented optical element having a resin layer formed on the surface of a base member that is a glass lens, wherein the resin composition has a refractive index before polymerization curing of 1.52 or

more, as is recited in amended claim 1 of the present invention (see lines 4-13 of page 14 of the specification and Table 1, page 34).

Thus, it is respectfully submitted that amended claim 1 of the present invention is not anticipated by Lin et al. (USPN 6,630,242) under 35 U.S.C. §102(e). Since claims 5, 7-8, 10-12 and 16 depend from amended claim 1, claims 5, 7-8, 10-12 and 16 are submitted to be not anticipated by Lin et al. (USPN 6,630,242) under 35 U.S.C. §102(e) for at least the reasons that amended claim 1 is submitted to be not anticipated by Lin et al. (USPN 6,630,242) under 35 U.S.C. §102(e).

In addition, if required, Applicants reserve the right to present a translation of the foreign priority papers to swear back the date of invention to the foreign priority date, by providing evidence to support an earlier date of invention from January 23, 2002 to at least July 23, 1999 to remove Lin et al. (whose priority date is October 4, 1999) as a reference.

C. In the Office Action, at pages 6-7, numbered paragraphs 17-18, claims 1, 7-8, and 13-18 were rejected under 35 U.S.C. §102(b) as being anticipated by Canon. This rejection is traversed and reconsideration is requested.

Claim 1 has been amended to recite that the base member is a glass lens and that said resin composition has a refractive index before polymerization curing of 1.52 or more. Claim 9 has been cancelled without prejudice or disclaimer.

It is respectfully submitted that Canon fails to teach or suggest a resin-cemented optical element having a resin layer formed on the surface of a base member that is a glass lens, wherein the resin composition has a refractive index before polymerization curing of 1.52 or more, as is recited in amended claim 1 of the present invention (see lines 4-13 of page 14 of the specification and Table 1, page 34).

Thus, it is respectfully submitted that amended claim 1 of the present invention is not anticipated by Canon (JP 62-258401) under 35 U.S.C. §102(b). Since claims 7-8 and 13-18 depend from amended claim 1, claims 7-8 and 13-18 are submitted to be not anticipated by Canon (JP 62-258401) under 35 U.S.C. §102(b) for at least the reasons that amended claim 1 is submitted to be not anticipated by Canon (JP 62-258401) under 35 U.S.C. §102(b).

REJECTION UNDER 35 U.S.C. §103:

A. In the Office Action, at page 7, numbered paragraph 20, claim 13 was rejected under 35 U.S.C. §103(a) as being unpatentable over Lin et al. The reasons for the rejection are set forth in the Office Action and therefore not repeated. The rejection is traversed and reconsideration is requested.

It is respectfully submitted that Lin et al. fails to teach or suggest a using a glass lens as a base member or a resin-cemented optical element having a resin layer formed on the surface of a base member that is a glass lens, wherein the resin composition has a refractive index before polymerization curing of 1.52 or more, as is recited in amended claim 1 of the present invention (see lines 4-13 of page 14 of the specification and Table 1, page 34).

In addition, the Examiner admits that Lin fails to teach the molecular weight of diacrylate reactive diluents. It is respectfully submitted that broad conclusory statements such as: "It would have been facie obvious to choose a reactive diluent having a low molecular weight to optimize the viscosity reducing properties of the diluent" are conclusory, i.e., point to nothing that suggests such a procedure. It is respectfully submitted that the absence of a convincing discussion of the specific sources of the motivation to make such a selection mainly begs the question and is based on hindsight, which is not permitted by the courts. *In re Werner Kotzab*, 217 F.3d 1365, 1371, 55 USPQ2d 1313, 1317 (Fed. Cir. 2000) ("[A] rejection cannot be predicated on the mere identification . . . of individual components of claimed limitations. Rather, particular findings must be made as to the reason the skilled artisan, with no knowledge of the claimed invention, would have selected these components for combination in the manner claimed."). Here, there was no such evidence presented. It is respectfully submitted that claim 1 is patentable over Lin et al. under 35 U.S.C. §103(a).

Since claim 13 depends from claim 1, claim 13 is submitted to be patentable over Lin et al. under 35 U.S.C. §103(a) for at least the reasons that claim 1 is patentable over Lin et al. under 35 U.S.C. §103(a).

B. In the Office Action, at pages 7-8, numbered paragraph 20, claim 19 was rejected under 35 U.S.C. §103(a) as being unpatentable over Canon in view of Sato. The reasons for the

rejection are set forth in the Office Action and therefore not repeated. The rejection is traversed and reconsideration is requested.

The Examiner admits that Canon fails to specify the use of coatings on lenses for interchangeable lenses, and asserts that it would have been *prima facie* obvious to combine the teachings of Sato with Canon. It is respectfully submitted that Cannon, in view of Sato, fails to teach or suggest a resin-cemented optical element having a resin layer formed on the surface of a base member that is a glass lens, wherein the resin composition has a refractive index before polymerization curing of 1.52 or more, as is recited in amended claim 1 of the present invention (see lines 4-13 of page 14 of the specification and Table 1, page 34). The courts have held that the Examiner may not suggest modifying references using the present invention as a template absent a suggestion of the desirability of the modification in the prior art. *In re Fitch*, 23 U.S.P.Q.2d 1780, Fed Cir. 1992. Something in the prior art as a whole must suggest the desirability, and thus, the obviousness, of making the combination. *Alco Standard Corp. v. Tennessee Valley Authority*, 808 F. 2d 1490, 1 U.S.P.Q. 2d 1337 (Fed. Cir. 1986). When a rejection depends on a combination of prior art references, there must be some teaching, suggestion or motivation to combine the references. *In re Geiger*, 815 F.2d 686, 688 2 U.S.P.Q.2d 1276, 1278 (Fed. Cir. 1987). Thus, since there is no teaching or suggestion of combining Canon with Sato, it is respectfully submitted that claim 1 is patentable over Canon in view of Sato under 35 U.S.C. §103(a).

Since claim 19 depends from claim 1, claim 19 is submitted to be non-obvious over Canon in view of Sato under 35 U.S.C. §103(a) for at least the reasons that claim 1 is submitted to be non-obvious over Canon in view of Sato under 35 U.S.C. §103(a).

CONCLUSION:

In accordance with the foregoing, it is respectfully submitted that all outstanding objections and rejections have been overcome and/or rendered moot, and further, that all pending claims patentably distinguish over the prior art. Thus, there being no further outstanding objections or rejections, the application is submitted as being in condition for allowance which action is earnestly solicited.

If the Examiner has any remaining issues to be addressed, it is believed that prosecution can be expedited by the Examiner contacting the undersigned attorney for a telephone interview to discuss resolution of such issues.

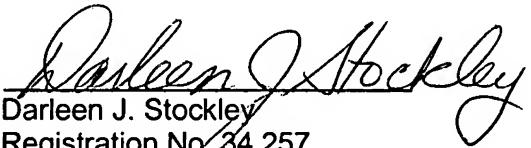
If there are any underpayments or overpayments of fees associated with the filing of this Amendment, please charge and/or credit the same to our Deposit Account No. 19-3935.

Respectfully submitted,

STAAS & HALSEY LLP

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By:


Darleen J. Stockley
Registration No. 34,257

1201 New York Avenue, N.W.
Suite 700
Washington, D.C. 20005
Telephone: (202) 434-1500
Facsimile: (202) 434-1501